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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,869	07/22/2003	Theodore G. Duclos	99-0033/COA (8470-114COA)	7658
29293 7590 09/25/2007 FREUDENBERG-NOK GENERAL PARTNERSHIP LEGAL DEPARTMENT 47690 EAST ANCHOR COURT PLYMOUTH, MI 48170-2455			EXAMINER RODRIGUEZ, RUTH C	
			ART UNIT 3677	PAPER NUMBER
			NOTIFICATION DATE 09/25/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/624,869	Applicant(s) DUCLOS ET AL.	
	Examiner Ruth C. Rodriguez	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-15, 17-25 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-25 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/3/06 & 8/28/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 August 2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7-11, 14, 15, 17-19, 21, 22, 24, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey (US 3,033,582) in view of Udagawa (US 6,186,513).

With respect to claims 1, 7, 10, 17, 18, 22, and 25, Creavey discloses a static gasket sealing between first (21) and second (20) sealing surfaces that are secured

together. Creavey also discloses a generally flat carrier member (11) having a generally planar top surface, a first stopper member (15), second stopper member (16), a cavity formed between the stopper members, and the stopper members having a height above the top surface of the carrier member. The second stopper member (17) has a height greater than that of the first stopper member (16). Creavey further discloses an elastomeric seal member (17) inside the cavity, having a sealing bead with an apex greater than the height of the first and second stoppers. The apex is adapted to compress to the height of the first and second stoppers as (shown in figures 3-5), where the stoppers prevent the seal member (17) from being over compressed. Creavey further discloses a second pair of stoppers on an opposite surface (bottom portion of gasket, mirror image stoppers 16, 17), where the stoppers have a height above the opposite surface. Additionally, Creavey shows a second elastomeric sealing member (mirror of 17, bottom portion of gasket in figures 3-5). The second pair of stoppers limits the compression of the second elastomeric sealing members. Creavey shows the first and second stoppers formed integrally, not independently from the carrier member. However, Udagawa teaches a gasket assembly where a stopper member may be formed either integrally (E12 in figure 6) or independently (F12 in figure 4) from a carrier member (E or F). From this Udagawa shows that stoppers formed integrally and independently of base members are equivalent and interchangeable within the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the stoppers of Creavey either integral or independent

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from the carrier member, as these are equivalent ways of including stoppers in a gasket arrangement.

Examiner notes that are several limitations regarding a method of loading the gasket, or an intended use of the gasket, such as, "A clamp load is applied", and the gasket is "subjected to the clamp load". It is noted that Creavey discloses all of the claimed structural elements, and is capable of being loaded as claimed by applicant. It is further noted that the reactive from the surfaces 20 and 21 of Creavey are identical to the forces that would arise from the clamping forces recited in the claims. Furthermore, the claims are drawn only to the gasket itself. Creavey meets all of the structural limitations of the gasket.

With respect to claims 2-4, Creavey discloses the sealing bead to be a triangle, the volume of the cavity is greater than the volume of the elastomeric seal member, and the elastomeric seal member is formed from a fluorocarbon. U.S. Patent No. 4,460,155 to Smith is cited as an evidentiary reference to show that Teflon (used by Creavey) is a fluorocarbon. Examiner cites Smith column 3, lines 32-34 to show this.

With respect to claims 8, 9, and 21, Creavey discloses the first and second stopper members (16, 17) are metal, and the apex is compressed 1.5% to 70%.

With respect to claims 11 and 19, examiner notes these appear to be a product-by-process claim, where a process of making the product is claimed, in a product claim. Claims 11 and 19 are product claims. As such, only the physical structure of the claim is considered. Any prior art reference that meets the structural limitations is considered to be capable of being made in the claimed manor. Examiner asserts that the

elastomeric sealing members of Creavey are capable of being formed from any of the claimed cure systems, and the first stopper member is capable of being molded on the carrier.

With respect to claim 14, Creavey's carrier (11) is made of metal.

With respect to claims 15 and 24, Creavey does not explicitly disclose the stopper members to have a shape factor between .15 and 10. However, since there is no showing of criticality of the recited range, such recited range would have been obvious to one of ordinary skill in the art. Altering the shape factor of an element is considered to a design choice within the skill of the art.

4. Claims 17 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (US 2,513,178) in view of Udagawa.

Jackson discloses a static gasket sealing between first and second sealing surfaces comprising a generally flat carrier (portion between seals 13, in figure 5) with generally planar first surface and a second surface facing the respective sealing surfaces, and a first stopper member (raised portion to left of 13, in figure 5) with a first height. Jackson further discloses an elastomeric seal (13) formed on the first surface with a height greater than the first height. The elastomeric seal (13) has a thickness greater than that of the carrier. Jackson shows the first stopper formed integrally, not independently from the carrier member. However, Udagawa teaches a gasket assembly where a stopper member may be formed either integrally (E12 in figure 6) or independently (F12 in figure 4) from a carrier member (E or F). From this Udagawa shows that stoppers formed integrally and independently of base members are

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equivalent and interchangeable within the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the stoppers of Jackson either integral or independent from the carrier member, as these are equivalent ways of including stoppers in a gasket arrangement.

5. Claims 5, 6, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey in view of Udagawa, as applied to claims 1, 10, and 17 above, and further in view of Combet et al (US 6,390,479).

The combination of Creavey and Udagawa serves to reject claims 1, 10 and 17 as recited above. Creavey and Udagawa are silent with regard to the dimensions of the carrier member. However, Combet teaches a carrier member having a thickness of less than 1.0 mm and the compressed thickness is in the range of 0.015 and 1.75 mm (column 3, line 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to change the thickness of the prior art carrier since such a modification is a design consideration within the skill of the art. In re Rose, 220 F.2d, 105 USPQ 237 (CCPA 1955).

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey in view Udagawa, as applied to claim 17 above, and further in view of Lucas et al (US 4,635,949).

The combination of Creavey and Udagawa serves to reject claim 17 as recited above. Creavey and Udagawa fail to disclose an adhesive layer on the second surface of the carrier member. However, Lucas teaches a gasket assembly where a seal ring (8) is bonded to the carrier, or sheet, (1) by a heat resistant adhesive. The adhesive

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positively secures the seal (8) to the carrier (1). It would have been obvious to one having ordinary skill in the art at the time of the invention to positively secure the seal (17) to the carrier member (11) of Creavey. This results in an adhesive layer on the second surface of Creavey.

Response to Arguments

7. Applicant's arguments filed 28 August 2007 have been fully considered but they are not persuasive.

8. The Applicant argues that Creavey, Jackson and Udagawa fail to disclose a "generally flat" carrier and a "generally planar top surface". The Examiner fails to agree with this argument because the term "generally" is considered broad term and encompasses other structures that are not flat for the carrier and that are not planar for the top surface. In this case, Creavey discloses a "generally flat carrier" and a "generally planar top surface" when the broadest interpretation is provided to the term "generally".

9. An argument presented by the Applicant against the combination of Udagawa and Creavey is that Udagawa only teaches a single stopper. This argument fails to persuade because Udagawa is not being used for its teaching of a single stopper member. Udagawa is being used for its teaching that about the equivalency of a stopper that can be integrally made with the carrier member or a stopper that can be formed independently from the carrier member. Especially since Creavey already

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discloses a first stopper member and a second stopper member that are integrally formed with the carrier member and Udagawa is being used for its equivalency teaching of a stopper member that can be integrally or independently formed with the carrier member.

10. The arguments presented against Pouquet et al. (US 6,530,575) are noted but are considered irrelevant since this reference is not being used to reject the claims.

However, the Examiner will like to point out that a combination of Pouquet and Udagawa will also render the claims rejectable since Udagawa teaches that a stopper that can be integrally made with the carrier member or a stopper that can be formed independently from the carrier member.

11. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the first and second stopper member are integrally formed with a "top surface" of a carrier portion of the gasket) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, this argument fails to persuade because the claim only require that the first and/or second stopper members be formed independently from the carrier member but does not recite that the first and/or second stopper members need to separate from the carrier member or that they are not integral with the carrier member. Additionally, such a limitation will be considered new matter since the disclosure does

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not provide support for the first and/or second stopper members that are separate from the carrier member or that are not integral with the carrier member.

12. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). For the claims that use the teachings of Udagawa, the claims would have been obvious because the substitution of one known element for another (stopper member being integral or separately formed from the carrier member) would have yielded predictable results to one of ordinary skill in the art at the time of the invention. *In re Fout*.

13. In the case of Combet, a person of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Combet with respect to the dimension of the gasket to achieve the claimed invention and that there would have been a reasonable expectation of success since Combet teaching that the dimensions being claimed are known in the art and there are applications where a gasket provided with these dimensions is required. *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007).

14. For those claim that applied the teachings of Lucas, a person or ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Lucas with respect to the use of an adhesive for the gasket to achieve the claimed invention and that there would have been a reasonable expectation of success since the use of adhesive in combination with gaskets is known in the gasket art and such a combination will only yield a predictable result of enhancing the bond of the second surface of the carrier to an adjacent surface since the adhesive will improve such a bond. *KSR International Co. v. Teleflex Inc*, 550 U.S., 82 USPQ2d 1385 (2007).

15. The same response to the arguments provided in the ninth paragraph above apply to the arguments provided by the Applicant on 28 August 2007 at the first paragraph of the fourth page since the Examiner is not replacing the entire gasket of Creavey or Jackson with the gasket of Udagawa. The rejection only replaces how the first and second stopping members are formed with respect to the carrier member.

16. The Applicant argues that Creavey fails to disclose that "said sealing bead having an apex which extends from said top surface and is greater than said height of said first and second stopper members" as recited in the claim 1 because the portion 13 extends above stopper member 16. This argument fails to persuade. Portion 13 is part of the top surface of carrier member that can have irregularities since the carrier member has a "generally planar top surface" as explained above. The sealing bead, has an apex that extends from the top surface (portion 13) and is greater than the height of the first and second stopper members is illustrated in Figure 3 of Creavey where the apex 30 engages surface 21 while stopper members 15 and 16 are not

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engaged to the surface 21 and this could only be possible if the apex of the sealing bead has a height greater than the height of the first and second stopper members.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase the patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as PTO's mailroom processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring

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a fee that the applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
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(Typed or printed name of person signing this certificate)

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response has been transmitted by facsimile will cause further unnecessary delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/RCR/
Ruth C. Rodriguez
Patent Examiner
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/James R. Brittain/
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rcr
September 17, 2007